

on pages 3-4 of the Office Action and numbered (i) to (vi). Applicant addresses each point of rejection in turn below:

(i) According to the Examiner, the recitation in claims 16 and 35-37 of "hydrocarbon-based" is indefinite because it is unclear if  $R_3$  comprises something other than hydrocarbons. Claims 16 and 35-37 have been amended to remove the term "hydrocarbon-based" and instead recite " $R_3$  is a *hydrocarbon* radical having from 4 to 36 carbons." Accordingly, this point of rejection has been rendered moot and should be withdrawn.

(ii) The Examiner has rejected claim 20 for reciting "obtained by" because it is unclear if the combination of hexamethylene diisocyanate and polyethylene glycol results in formula (I). Applicant respectfully traverses the rejection because one of ordinary skill in the art would immediately understand that the compound of formula (I) with the parameters recited in claim 20 is obtained by the polycondensation of hexamethylene diisocyanate and polyethylene glycol, as explained in the specification at page 6, lines 15-23. For this reason, the claims particularly point out and distinctly claim the subject matter of the invention and this point of rejection should be withdrawn.

(iii) Claim 21 is rejected for reciting "chemically, enzymatically or microbiologically modified soluble starch" because it is allegedly not clear what chemical compound is being claimed due to the variations in starches produced by such means. Applicant respectfully traverses this rejection because one of ordinary skill in the art would readily be able to take any of the starches disclosed in the specification and modify them chemically, enzymatically or microbiologically using standard and routine methods known in the art. These methods would then make the starches soluble in water as

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disclosed on page 6, lines 9-14. For this reason, the claims particularly point out and distinctly claim the subject matter of the invention and this point of rejection should be withdrawn.

(iv) The Examiner has rejected claim 27 for reciting "higher C<sub>8</sub>-C<sub>22</sub> fatty acids" because it is unclear if "higher" refers to C<sub>8</sub>-C<sub>22</sub> or to the upper carbons of the recited range, such as C<sub>20</sub>-C<sub>22</sub>. Claim 27 has been amended to delete the word "higher". Accordingly, this point of rejection has been rendered moot and should be withdrawn.

(v) Claims 30-33 are rejected for reciting "% by weight of active material" because it is unclear what the active material is. Claims 30-33 have been amended to remove "of active material." Because this point of rejection is rendered moot by the amendment to claims 30-33, it should be withdrawn.

(vi) Finally, the Examiner has rejected claims 22, 26, and 29 for reciting the term "derivatives" because, in her view, the metes and bounds of the claims are unascertainable. Applicant respectfully traverses the rejection because the term "derivatives" is well known to those in the chemical arts, as demonstrated by the use of this term in chemical patents. For this reason, one of ordinary skill in the art would know what is encompassed by the use of such a phrase. For example, one of ordinary skill in the art would know that a derivative must possess functional properties similar to those of the parent compound even though the structure of the derivative may vary due to small variations in the substituents. For this reason, the claims particularly point out and distinctly claim the subject matter of the invention and this point of rejection should be withdrawn.

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In view of the foregoing amendment and remarks, Applicant respectfully requests the reconsideration and withdrawal of the rejection.

### III. DOUBLE PATENTING REJECTIONS

#### A. U.S. Patent No. 6,080,392 to Dupuis

The Examiner has maintained the rejection of claims 16-37 under the judicially created doctrine of obviousness-type double patenting over claims 1-30 of U.S. Patent No. 6,080,392 (Dupuis). Applicant disagrees. In her view, the composition of independent claim 1 of Dupuis in no way renders obvious the compositions and methods of use recited in claims 16-37.

As the Examiner is aware, "[a] double patenting rejection of the obvious type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. § 103' except that the patent [application] principally underlying the double patenting rejection is not considered prior art." M.P.E.P. § 804(B)(1) (8<sup>th</sup> ed. 2001). Furthermore, "any analysis employed in an obvious-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. [§] 103 obviousness determination." *Id.*

Consequently, under established court guidance interpreting 35 U.S.C. § 103, the Examiner must provide motivation to modify the claims of this application. In an obviousness rejection, the motivation provided by the Examiner must flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination."); *accord In re Geiger*,

815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989) ("[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)). Likewise, the Federal Circuit in *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988), insisted that "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." Furthermore, this "prior art" teaching may not come from the disclosure of the applicant; only the claims of the applicant may be used to formulate the rejection. *In re Braat*, 937 F.2d 589, 594 n.5 (Fed. Cir. 1991).

Independent claim 1 of Dupuis requires that the composition is pressurized as an aerosol in the presence of a propellant and is capable of forming a mousse. In contrast, the claims of the present invention do not require (1) that the composition is pressurized as an aerosol, the (2) the presence of a propellant, and (3) that the composition is capable of forming a mousse. For at least these reasons, the claims are patentably distinct from Dupuis.

Moreover, the Examiner has provided no motivation to modify the claims of Dupuis to eliminate the three elements listed above. Under the current standard of law, the Examiner must provide some sort of evidence -- a patent, scientific reasoning, a scientific article, etc.—of a suggestion or motivation to modify the claims of Dupuis to reach the presently claimed invention. Furthermore, as set forth in *Braat*, the Examiner cannot use information contained in the applicant's specification as motivation to modify

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the claims of the present application. Absent appropriate evidence, therefore, the Examiner has failed to make a *prima facie* case of obviousness-type double patenting. Accordingly, Applicant respectfully requests the withdrawal of the obviousness-type double patenting rejection.

B. Co-pending Applications

Additionally, the Examiner has maintained the provisional rejection of claims 16-37 under the judicially created doctrine of obviousness-type double patenting over the claims of copending Application Nos. 09/265,850; 09/402,801; and 09/402,797. The Examiner argues that this is a provisional rejection because the conflicting claims have not in fact been patented. See Office Action dated July 31, 2002, at 3.

To the contrary, however, Applicant notes that Application No. 09/265,850, filed on March 11, 1999, issued as U.S. Patent No. 6,383,472 on May 7, 2002. Moreover, Application No. 09/402,797, filed as a PCT application on December 23, 1998, issued as U.S. Patent No. 6,258,367 on July 10, 2001.

1. ***U.S. Application No. 09/265,580 (now U.S. Patent No. 6,383,473)***

With respect to Application No. 09/265,850, now U.S. Patent No. 6,383,472, Applicant respectfully traverses the double patenting rejection. Independent claim 1 of U.S. Patent No. 6,383,472 requires that the composition is pressurized as an aerosol in the presence of a propellant and is capable of forming a mousse. In contrast, the claims of the present invention do not require (1) that the composition is pressurized as an aerosol, the (2) the presence of a propellant, and (3) that the composition is capable of forming a mousse. For at least these reasons, the claims are patentably distinct from U.S. Patent No. 6,383,472.

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Moreover, as with the rejection over Dupuis, discussed above, the Examiner has not pointed to any evidence of motivation to modify U.S. Patent No. 6,383,472 to obtain the presently claimed invention. Further, the Examiner cannot use information contained in the applicant's specification as motivation to modify the present claims. The Examiner has failed on both counts here and thus has failed to make a valid *prima facie* case of obviousness-type double patenting. Therefore, applicant respectfully requests the withdrawal of the obviousness-type double patenting rejection.

**2. U.S. Application Nos. 09/402,797 and 09/402,801**

As noted above, Application No. 09/402,797, filed as a PCT application on December 23, 1998, issued as U.S. Patent No. 6,258,367 on July 10, 2001. Application No. 09/402,801, filed as a PCT application on December 22, 1998, is still pending. With respect to this parent and this application, attached hereto is an executed Terminal Disclaimer. Although Applicant does not agree with the rejections or acquiesce to them in any way, the filing of the Terminal Disclaimer renders both of these obviousness-type double patenting rejections moot.

In view of the executed Terminal Disclaimer and Applicant's remarks, reconsideration and withdrawal of the rejections are respectfully requested.

**IV. REJECTION UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 16-37 under 35 U.S.C. § 103(a) over U.S. Patent No. 6,080,392 (Dupuis) in view of U.S. Patent No. 4,155,892 (Emmons) and

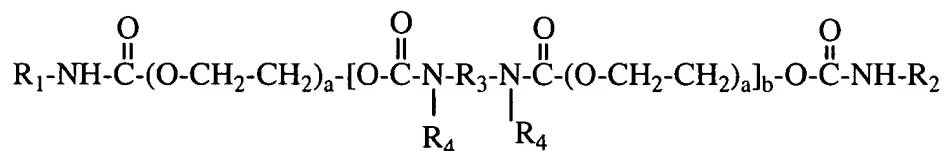
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further in view of U.S. Patent No. 5,385,729 (Prencipe)<sup>1</sup>. Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There must also be a reasonable expectation of success in making the modification or combination. M.P.E.P. § 2143 (7<sup>th</sup> ed. 1998). Furthermore, the evidence of a teaching, suggestion, or motivation to combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Here, the Examiner has now shown any suggestion or motivation to combine the references, let alone clear and particular evidence for doing so, or a reasonable expectation of success if the combination were made.

The present invention, as recited in, *e.g.*, claim 16, is drawn to a cosmetic composition comprising, in a cosmetically acceptable medium, (A) at least one nonionic amphiphilic associative polyurethane corresponding to formula (I):



in which one of the radicals R<sub>1</sub> and R<sub>2</sub> is an C<sub>8</sub>-C<sub>18</sub> alkyl group and the other is a C<sub>1</sub>-C<sub>6</sub> alkyl group, and the other substituents in formula (I) are as disclosed in, *e.g.*, claim 16.

The Examiner admits that Dupuis "lacks a specific teaching of R having 1 to 6 carbon atoms." See Office Action dated July 31, 2002, at 5. To make up for this deficiency, the Examiner relies on Emmons for teaching polyurethane thickeners

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1 Per Examiner Interview Summary Record dated September 16, 2002.

comprising hydrophobic end units comprising 4 to 20 carbon atoms. The Examiner argues that based on these teachings, it would have been obvious to modify Dupuis' compound to include a hydrophobic end unit having 1 to 6 carbon atoms as taught by Emmons because "one would expect a polyether-polyurethane compound having 4-8 carbon atoms to have similar thickening properties in cosmetics." See Office Action dated July 31, 2002, at 6.

**A. Dupuis Does Not Provide the Requisite Motivation To Modify Her Disclosed Compound**

Dupuis does not teach or suggest that her compound should have hydrophobic end units with different carbon chain lengths. Specifically, Dupuis does not teach or suggest that the end units should have 1 to 6 carbon atoms on one end and 8 to 18 carbon atoms on the other end, as presently claimed. Moreover, the Examiner has failed to establish that Dupuis provides any motivation for having a compound with end units of different carbon length.

Further, the Examiner has not established why one of ordinary skill in the art would have been motivated to modify Dupuis' polyether polyurethane. Presumably, there is nothing wrong with the thickening properties of the disclosed polyurethane and there is no teaching or suggestion in Dupuis to lead one of ordinary skill in the art to believe that by altering the carbon length of one of the end units the thickening properties will improve. In other words, there would have been no reasonable expectation of success in modifying Dupuis, so the Examiner's prima facie case fails here as well.

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**B. Emmons Does Not Provide the Requisite Motivation To Modify Dupuis' Disclosed Compound**

Emmons teaches compounds with terminal hydrophobic end units. See col. 2, lines 46-49. At most, Emmons teaches that in compounds having end units with lower alkyl groups, such as four carbon atoms, the end units should be the same length, *e.g.*, four carbon atoms. See examples 26, 39, and 97. Although Emmons exemplifies hundreds of compounds, only examples 26, 39, and 97 appear to contain a lower alkyl group (C4) end unit. Each of these three examples shows a compound with identical end units.

Emmons also teaches that compounds having end units with higher alkyl groups, such as greater than eight carbon atoms, should also have a higher alkyl group at the other end unit. See, *e.g.*, examples 1-25. Emmons does not teach or suggest that a compound should have one end unit with lower alkyl groups and another with higher alkyl groups, let alone specifically teach or suggest one end unit with 1 to 6 carbon atoms and the other with 8 to 18 carbon atoms. Because Emmons does not teach or suggest a compound having one end unit with 1 to 6 carbon atoms and the other with 8 to 18 carbon atoms, it certainly cannot be relied upon as providing the requisite motivation to modify Dupuis' compound in this manner.

**C. The Examiner has Failed to Establish a Reasonable Expectation of Success**

Further, although the Examiner has asserted that the proposed modification to Dupuis would have been obvious because of the expectation of similar thickening properties, the Examiner has failed to provide any evidence to support this position. While Emmons teaches compounds with similar ends (both lower alkyl groups or both

higher alkyl groups), Emmons does not provide any evidence of the thickening properties of a compound with one lower alkyl group and one higher alkyl group. For this reason, Emmons provides no evidence that such a compound would have similar thickening properties.

Moreover, as discussed above, the Examiner has not established why one of ordinary skill in the art would have been motivated to modify Dupuis' polyether polyurethane. Dupuis does not teach or suggest that that having different carbon lengthened end units will result in a compound having similar thickening properties. Presumably, there is nothing wrong with the thickening properties of the disclosed polyurethane and there is no teaching or suggestion in Dupuis to lead one of ordinary skill in the art to believe that by altering the carbon length of one of the end units the thickening properties will improve. In other words, there would have been no reasonable expectation of success in modifying Dupuis.

**D. Prencipe Does Not Overcome the Deficiencies of the Other References**

The Examiner relies on Prencipe for teaching styrene phosphonic acids and vinyl phosphonic acid units comprising a cross-linking polymeric thickening agent. See Office Action at page 6. The Examiner appears to be using this reference to attack the dependent claims directed to the monomer units used to make the claimed at least one anionic polymer. Nevertheless, this reference, alone or in combination with the other cited references, would not have rendered obvious the claimed invention for the reasons discussed above.

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**E. Unexpected Results**

Finally, the Examiner argues that the applicant has the burden of demonstrating unexpected results over the closest prior art. However, because Applicant believes that the Examiner has failed to establish a *prima facie* case of obviousness, it is not necessary for her to provide such rebuttal evidence.

For at least the foregoing reasons, the cited references, alone or in combination, would not have rendered obvious the claimed invention. Reconsideration and withdrawal of the rejection are respectfully requested.

**V. CONCLUSION**

In view of the foregoing amendments and remarks, Applicant requests reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 24, 2002

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